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46320	7590	02/07/2018	EXAMINER MUELLER, KURT A	
CRGO LAW STEVEN M. GREENBERG 7900 Glades Road SUITE 520 BOCA RATON, FL 33434			ART UNIT 2157	PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ADAM R. CLARKE, MATTHEW J. HICKS,  
and JOSEPH J. KUBIK

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Appeal 2017-002636  
Application 11/421,250<sup>1</sup>  
Technology Center 2100

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Before: MAHSHID D. SAADAT, THU A. DANG, and  
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants filed a paper under 37 C.F.R. § 41.52 requesting reconsideration of our November 14, 2017, Decision where we affirmed the rejections of claims 31 and 36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter and affirmed claims 21, 23, 24, 26, 31, 33, 34, and 36 under 35 U.S.C. § 102(b) as being anticipated over Gelernter (US 2004/0139396 A1; published July 15, 2004) (hereinafter, “Gelernter”). Appellants specifically request Rehearing with respect to independent claims 21, 23, 24, 26, 31, 33, 34, and 36. Req. Reh’g 2–4.

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<sup>1</sup> According to Appellant, is International Business Machines Corp., the real party in interest. App. Br. 2.

We have reconsidered the Decision in light of Appellants' arguments in the Request for Rehearing, but find no errors. Therefore, we do not modify the Decision for the reasons discussed below.

## ANALYSIS

### 35 U.S.C. § 101

Appellants argue we acknowledged, but neglected to address whether: (1) the claimed device can be a “signal” when the claim 31 language recites a memory device that stores computer usable program code for data streaming a document such that the program code executes on a computer hardware device that has a processor and a memory, and causes the computer hardware device to perform the method of the invention (Req. Reh’g 2–3); and (2) *In re Nuijten* concludes that a physical device storing program code is a signal (*Id.* at 3). We disagree with Appellants.

Although we acknowledged those two arguments (*see* Dec. 3) as Appellants point out (Req. Reh’g 2–3), we need not address those two arguments because *Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential) (“Mewherter”) is dispositive of the 35 U.S.C. § 101 issue for the reasons *infra*.

In the precedential *Mewherter* Decision, the Board held that a recited machine-readable storage medium was ineligible under 35 U.S.C. § 101 since it included transitory signals. *Mewherter*, slip op. at 4–14 (PTAB 2013). Notably, the Specification was silent regarding the nature of medium and the ordinary and customary meaning of the term “storage” did not exclude transitory media (e.g., signals). *Id.*

Similarly, in the present case, claims 31 and 36 recite a “storage memory device.” Significantly, claim 31 does not recite “non-transitory.” What is also significant is that the specification does not recite verbatim a “computer-readable storage memory device.” *See generally* Spec. Also significant is the Specification’s disclosure of “memory 110 . . . can comprise any combination of various types of data storage and/or **transmission media**” and “computer-readable/usable medium can comprise . . . **a data signal (e.g., a propagated signal)** traveling over a network (e.g., during a **wired**/wireless electronic distribution of the program code).” Spec. ¶¶ 43, 48 (emphases added). Therefore, the broadest reasonable interpretation of “computer-readable storage memory device” is a data signal (e.g., a propagated signal) traveling over a wire.

Accordingly, Appellants’ contentions do not persuade us of error in our November 14, 2017, Decision.

### **35 U.S.C. § 102(b)**

Appellants argue we failed to address claim 21’s preamble reciting the document includes a content body and metadata, claim 21’s requirement that a data type is created as a pointer to the content body of the document, claim 21’s requirement that the created data type (the pointer) is attached to the metadata, which means attaching of a pointer to the metadata of a document in the document itself. Req. Reh’g 4. We disagree with Appellants.

Appellants’ argument fails because claim 21 (and similarly recited claim 31) does not state explicitly or implicitly “attaching of a pointer to meta data of a document in the document itself” for the following reasons. Claim 21’s preamble recites a document including a content body and

metadata. Claim 21 requires that a data type is created as a pointer to the content body of the document and that the created data type (i.e., the pointer) is attached to the metadata. Because claim 21's preamble recites a document includes metadata, this does not mean the attachment of a pointer to metadata of a document is "in the document itself." Rather, claim 21 can be construed reasonably to state implicitly "attaching of a pointer to meta data of a document" not necessarily in the document itself. Put another way, the broadest reasonable interpretation of claims 21 and 31 includes an interpretation that an attachment of a pointer to metadata of a document can be outside of the document.

Therefore, Appellants' contentions do not persuade us of error in our November 14, 2017, Decision.

### CONCLUSION

Appellants' Request does not persuade us of any points we misapprehended or overlooked in the Decision, or that we misapplied the relevant law. For the reasons stated *supra*, we have granted Appellants' request to the extent that we have reconsidered our decision, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED